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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/737,616	12/15/2000	Sundeeb Bhan	258/282	7989
21890	7590	02/26/2004	EXAMINER	
PROSKAUER ROSE LLP PATENT DEPARTMENT 1585 BROADWAY NEW YORK, NY 10036-8299			GRAVINI, STEPHEN MICHAEL	
			ART UNIT	PAPER NUMBER
			3622	

DATE MAILED: 02/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/737,616

Applicant(s)

BHAN ET AL.

Examiner

Stephen M Gravini

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 05 November 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### **Requirements for Information**

37 CFR 1.105 states: (a) (1) In the course of examining or treating a matter in a pending or abandoned application filed under 35 U.S.C. 111 or 371 (including a reissue application), in a patent, or in a reexamination proceeding, the examiner or other Office employee may require the submission, from individuals identified under § 1.56(c), or any assignee, of such information as may be reasonably necessary to properly examine or treat the matter, for example:

- (i) Commercial databases : The existence of any particularly relevant commercial database known to any of the inventors that could be searched for a particular aspect of the invention.
- (ii) Search : Whether a search of the prior art was made, and if so, what was searched.
- (iii) Related information : A copy of any non-patent literature, published application, or patent (U.S. or foreign), by any of the inventors, that relates to the claimed invention.
- (iv) Information used to draft application : A copy of any non-patent literature, published application, or patent (U.S. or foreign) that was used to draft the application.

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(v) Information used in invention process : A copy of any non-patent literature, published application, or patent (U.S. or foreign) that was used in the invention process, such as by designing around or providing a solution to accomplish an invention result.

(vi) Improvements : Where the claimed invention is an improvement, identification of what is being improved.

(vii) In Use : Identification of any use of the claimed invention known to any of the inventors at the time the application was filed notwithstanding the date of the use.

(2) Where an assignee has asserted its right to prosecute pursuant to § 3.71(a) of this chapter, matters such as paragraphs (a)(1)(I), (iii), and (vii) of this section may also be applied to such assignee.

(3) Any reply that states that the information required to be submitted is unknown and/or is not readily available to the party or parties from which it was requested will be accepted as a complete reply.

(b) The requirement for information of paragraph (a)(1) of this section may be included in an Office action, or sent separately.

(c) A reply, or a failure to reply, to a requirement for information under this section will be governed by §§ 1.135 and 1.136.

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The Office is requiring submission of information reasonably necessary to properly examine and treat the claimed subject matter under Rule 105. Of particular interest is information used in drafting the present operation including information related to the field of endeavor or business practices used by applicants' professional business ventures, to show the information used in the invention process, and identification of any use of the claimed invention known to the inventor at the time the application was filed notwithstanding the date of the use. Since the application is filed as a small entity status, along with the fact that the assignee has other pending applications and/or other patented inventions closely related to the claimed invention along with trademarks demonstrating the claimed invention is well defined in the stream of commerce and no information disclosure statement has been filed, it appears that it would be appropriate to require the applicants to provide information necessary to ensure a quality examination may be performed by the Office.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

As an initial matter, the United States Constitution under Art. I, §8, cl. 8 gave Congress the power to "[p]romote the progress of science and useful arts, by securing

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for limited times to authors and inventors the exclusive right to their respective writings and discoveries". In carrying out this power, Congress authorized under 35 U.S.C. §101 a grant of a patent to "[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition or matter, or any new and useful improvement thereof." Therefore, a fundamental premise is that a patent is a statutorily created vehicle for Congress to confer an exclusive right to the inventors for "inventions" that promote the progress of "science and the useful arts". The phrase "technological arts" has been created and used by the courts to offer another view of the term "useful arts". See *In re Musgrave*, 167 USPQ (BNA) 280 (CCPA 1970). Hence, the first test of whether an invention is eligible for a patent is to determine if the invention is within the "technological arts".

Further, despite the express language of §101, several judicially created exceptions have been established to exclude certain subject matter as being patentable subject matter covered by §101. These exceptions include "laws of nature", "natural phenomena", and "abstract ideas". See *Diamond v. Diehr*, 450, U.S. 175, 185, 209 USPQ (BNA) 1, 7 (1981). However, courts have found that even if an invention incorporates abstract ideas, such as mathematical algorithms, the invention may nevertheless be statutory subject matter if the invention as a whole produces a "useful, concrete, and tangible result." See *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* 149 F.3d 1368, 1973, 47 USPQ2d (BNA) 1596 (Fed. Cir. 1998). Together, the "technological arts" and "useful, concrete, and tangible result" judicial review standard, result in a comprehensive examination standard wherein the "technological

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arts" is one element and the "useful, concrete, and tangible result" is another complementary element.

This comprehensive examination standard was evident when the Court of Customs and Patent Appeals (CCPA) decided an appeal from the Board of Patent Appeals and Interferences (BPAI). See *In re Toma*, 197 USPQ (BNA) 852 (CCPA 1978). In *Toma*, the court held that the recited mathematical algorithm did not render the claim as a whole non-statutory using the Freeman-Walter-Abele test as applied to *Gottschalk v. Benson*, 409 U.S. 63, 175 USPQ (BNA) 673 (1972). Additionally, the court decided separately on the issue of the "technological arts". The court developed a "technological arts" analysis:

The "technological" or "useful" arts inquiry must focus on whether the claimed subject matter...is statutory, not on whether the product of the claimed subject matter...is statutory, not on whether the prior art which the claimed subject matter purports to replace...is statutory, and not on whether the claimed subject matter is presently perceived to be an improvement over the prior art, e.g., whether it "enhances" the operation of a machine. *In re Toma* at 857.

In *Toma*, the claimed invention was a computer program for translating a source human language (e.g., Russian) into a target human language (e.g., English). The court found that the claimed computer implemented process was within the "technological art" because the claimed invention was an operation being performed by a computer within a computer.

The decision in *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* never addressed this prong of the test. In *State Street Bank & Trust Co.*, the court found that the "mathematical exception" using the Freeman-Walter-Abele test has little,

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if any, application to determining the presence of statutory subject matter but rather, statutory subject matter should be based on whether the operation produces a "useful, concrete and tangible result". See *State Street Bank & Trust Co.* at 1374. Furthermore, the court found that there was no "business method exception" since the court decisions that purported to create such exceptions were based on novelty or lack of enablement issues and not on statutory grounds. Therefore, the court held that "[w]hether the patent's claims are too broad to be patentable is not to be judged under §101, but rather under §§102, 103 and 112." See *State Street Bank & Trust Co.* at 1377. Both of these analysis goes towards whether the claimed invention is non-statutory because of the presence of an abstract idea. Indeed, *State Street* abolished the Freeman-Walter-Abele test used in *Toma*. However, *State Street* never addressed the second part of the analysis, i.e., the "technological arts" test established in *Toma* because the invention in *State Street* (i.e., a computerized system for determining the year-end income, expense, and capital gain or loss for the portfolio) was already determined to be within the technological arts under the *Toma* test. The Board of Patent Appeals and Interferences (BPAI) have recently acknowledged this dichotomy in affirming a §101 rejection finding the claimed invention to be non-statutory. See *Ex parte Bowman*, 61 USPQ2d (BNA) 1669 (BPAI 2001).

Claims 1-21 are rejected under 35 U.S.C. 101 because the independently claimed invention does not recite a useful, concrete, and tangible result under *In re Alappat*, 31 USPQ2d 1545 (Fed. Cir. 1994) and *State Street Bank & Trust Co. v. Signature Financial Group Inc.*, 47 USPQ2d 1596 (Fed Cir. 1998) such that the claimed



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invention is within the technological arts under *In re Waldbaum* 173 USPQ 430 (CCPA 1972) wherein the phrase "technological arts" is synonymous with "useful arts" as it appears in Article I, Section 8 of the United States Constitution. In this claim, it is considered that a concrete and tangible result is not recited. Specifically, the recitation of inviting a user, presenting questions and accepting responses from the user, determining responses and providing a reward is considered not to produce a concrete result because a result cannot be assured or is not reproducible. That independently claimed recitation is considered an abstract concept that is non-enabling because it does not positively recite features within the technological arts. Furthermore, under *In re Wamerdam*, 33 F.3d 1354; 31 USPQ2d 1754 (Fed. Cir. 1994), the inviting, the user presenting and accepting, the determining and providing recitations are considered intangible because those steps are simply an abstract construct, such as a disembodied data structure and a method of making it, wherein those recitations involve more than a manipulation of an abstract idea and therefore is non-statutory under 35 USC 101. Because the independently claimed invention does not recite a useful, concrete, and tangible result, such that it is considered not within technological arts so that it uses technology in a non-trivial matter. Finally under *Ex parte Bowman*, 61 USPQ2d 1665 (Bd. Pat. App. & Inter. 2001) (unpublished but cited for analysis rather than precedent), in which an invention disclosed and claimed directed to a human merely making mental computations and manually plotting results on a paper chart is nothing more than an abstract idea which is not tied to any technological art and is not a useful art as contemplated by the United States Constitution. In this independently claimed invention, the steps of determining, retrieving, and providing are considered nothing more than an abstract idea since it is not tied to any technological art. However in order

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to consider those claims in light of the prior art, examiner will assume that those claims recite statutorily permitted subject matter.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-21 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Christensent et al. (US 5,710,886) or von Kohorn (US 5,759,101).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.

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3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over examiner's personal experience with quiz method for rewarding participants as provided by the popular television game show Jeopardy. The claimed web site, URL, database, and email are considered automated features of an old and well known manual operation, which will also be discussed infra. The claimed invention under examiner experience is based on the broadest reading of the claims under the *Graham* decision. Since at least 1984, examiner has experienced the game show Jeopardy, which has performed the claimed method comprising:

inviting a user to visit a site;

presenting material that promotes the product or service to the user when the user visits the site;

presenting questions to the user, wherein the questions relate to the material presented in the material-presenting step;

accepting, from the user, responses to the questions presented in the question-presenting step;

notifying the user when a response accepted in the accepting step is incorrect;

determining whether a sufficient number of responses accepted in the accepting step are correct; and

providing a reward to the user if it is determined, in the determining step, that a sufficient number of the responses are correct are part of examiner's personal

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experience. As a premise, examiner considers the format of Jeopardy to pose answers while questions are elicited from quiz show contestants. Although questions are not asked of contestants but rather answers, and answers are not solicited from contestants for prize money, but rather questions, the functionality is substantially similar if one were to patentably exchange the meanings of question and answer for the purpose of illustrating the functionality of examiner's experience in light of the claimed invention. Examiner's personal experience also includes the claimed tangible object distribution, 100 or 80 percent sufficiency, product or service promotion code, incorrect insufficiency with rewarding corrected accepted responses, time intervals, acceptance before subsequent presentation, and tracking responses. The claimed feature of inviting a user to visit a site is considered functionally equivalent to examiner observing a contestant on the quiz show site of Jeopardy being invited on stage to select a category of quiz answers (questions) to be questioned (answered). The claimed step of presenting material that promotes the product or service to the user when the user visits the site is considered functionally equivalent the examiner observing Jeopardy host, Alex Trebek, store quizzes on cards or display screen servers for audience display and then announcing a return after a short station break (usually for advertisements to promote products or services as claimed). The claimed step of presenting questions to the user, wherein the questions relate to the material presented in the material-presenting step is considered equivalent to the Jeopardy quiz show contestant participant to select a category and amount of payment (i.e. "Alex, I'll take American presidents for \$100"). The claimed step of accepting, from the user, responses to the

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questions presented in the question-presenting step is considered equivalent to the final round of Jeopardy, in which contestants are asked a certain quiz question/answer and told to write their answer/question on a quizzing screen which will be later displayed for the television audience. The claimed step of notifying the user when a response accepted in the accepting step is incorrect is considered functionally equivalent to the Jeopardy game show host or his back stage judgment panel determining if the question is judged right or wrong (i.e examiner has observed a contestant answer "who is Grant?" but was not given credit because the answer was not in the intended question format, "who is President Ulysses S. Grant?"). The claimed step of notifying the user when a response accepted in the accepting step is incorrect is considered functionally equivalent to the Jeopardy buzzer notifying a contest that the answer is incorrect or by Alex Trebek stating that the answer is incorrect. The claimed step of determining whether a sufficient number of responses accepted in the accepting step are correct is considered equivalent to the panel of Jeopardy contestants have achieved sufficient correct responses to be invited to participate on the Jeopardy game show at a subsequent date. The claimed step of providing a reward to the user if it is determined, in the determining step, that a sufficient number of the responses are correct is considered functionally equivalent to the Jeopardy game show being awarded the designated prize money for the selected quiz category (i.e. American presidents for \$100). The claimed tangible object distribution, 100 or 80 percent sufficiency, product or service promotion code, incorrect insufficiency with rewarding corrected accepted responses, time intervals, acceptance before subsequent presentation, and tracking

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responses are considered part of game show Jeopardy broadcast and participation rules included in examiner's experience. The claimed invention contains automated features, such as web site, URL, database, and email which are obvious automated variations to the examiner's experience such that the examiner will use Official notice to obviate that claimed subject matter. The web site, URL, database, and email, as claimed, are interpreted to encompass automated electronic communications associated with electronic mail, Internet, and/or computer to server communications that have been performed by television game shows using manual or semi-automated means incorporating manual means of the presently claimed automated invention. The claimed invention, recited by the applicant, is considered to have been provided to examiner by personal experience long before the filing of applicant's invention. Those terms are merely modern terms for the method used to carry out the functionality of the claimed invention. More specifically the claimed web site, URL, database, and email are considered modern day terms in describing television or radio broadcast communications used over broadcast networks in game show quizzing crediting participants with respect to rewarding answers to questions posed. Examiner notes that it is old and well known to those skilled in the art of the claimed method, that it would have been obvious to claim the invention as recited by the applicants, in order to overcome the explicit teachings of examiner's personal experience discussed supra. It would have been obvious to one skilled in the art to provide the automated claimed method, since those features, particularly are merely automated features of a concept that is old and well known. Please see *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193,

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194 (CCPA 1958) in which the court held that broadly providing an automatic or mechanical means to replace a manual activity which accomplished the same result is not sufficient to distinguish over the prior art. The motivation to combine applicants' claimed invention with the prizes offered by quiz show participants in answering quiz questions correctly or incorrectly under examiner experience is to allow greater participation through electronic mediums, while transferring information, which clearly shows the obviousness of the claimed invention. One would also be motivated to combine the teachings of examiner's experience with current computer and network innovations available such that much of quiz show objectives can be carried out in a more efficient manner through computer technology than manually calling various participants to travel to the broadcast location for quiz show participation. One would be further motivated to combine the rewards claimed with the quiz show such that one could participate in any designated quiz for examiner-like viewers to gain rewards for patronizing a quiz system or method.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Clicks not bricks: interactive television (reference U cited in this action) and Klayh (WO 00/38088) are considered relevant to the method of activation of coupons based on quiz or questionnaire.

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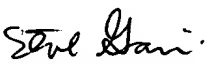
Any inquiry concerning this communication or earlier communication from the examiner should be directed to Steve Gravini whose voice telephone number is (703) 308-7570 and electronic transmission / e-mail address is "steve.gravini@uspto.gov". Examiner can normally be contacted Monday through Friday from 6:00 a.m. to 3:30 p.m. **If applicants choose to send information by e-mail, please be aware that confidentiality of the electronically transmitted message cannot be assured.**

Please see MPEP 502.02. Information may be sent to the Office by facsimile transmission. The facsimile transmission telephone numbers for TC-3600 are:

After-final (703) 872-9327

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Non-Official/Draft (703) 872-9325

  
STEPHEN GRAVINI  
PRIMARY EXAMINER

smg

February 20, 2004